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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Jeffrey D. Anderson et al.

Serial No.: 09/871,127

Filed: May 31, 2001

For: INTERNALLY THREADED FASTENER
AND STEMMED WASHER ASSEMBLY
AND METHOD FOR MAKING SAME

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Group Art Unit: 2561

Examiner: Schiffman, Jori

Atty. Docket: ITWO:0006/YOD
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Assistant Commissioner
for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING 37 C.F.R. 1.8
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:
12/17/02 <i>Helen Tinsley</i> Date Helen Tinsley

RESPONSE TO THE
OFFICE ACTION MAILED ON SEPTEMBER 17, 2002

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Dear Examiner:

This is in response to the Office Action mailed on September 17, 2002.
Applicants submit the following remarks.

In the Office Action, claims 1, 2, 4-9, 11-14, 26 and 27 were rejected. Applicants respectfully assert the claims, as previously presented, are in condition for allowance. In light of the following remarks, reconsideration and allowance of all pending claims are requested.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 4-9, 11-14 and 26 under 35 U.S.C. §102(b) as being anticipated by Goiny (US 4,969,788). Applicants respectfully traverse the rejection.



A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Contrary to the Examiner's contention, the Goiny reference does not disclose many of the features recited by the instant claims. For example, independent claim 1 recites, *inter alia*, "a standoff portion integral with the washer portion and extending therefrom." The Goiny reference fails to disclose, in any semblance, this feature. Rather, Goiny merely discloses a spherical washer 14 that distributes clamping forces induced by the nut to a complementarily shaped depression 16 pre-fabricated into a component 6 to be assembled. *See* Goiny, column 3, lines 39-50. At most, the element 14 of the cited reference discloses an arcuate washer employed to distribute pressures induced by the nut 10. Goiny's labeling of element 14 throughout the cited reference as a "pressure ring" indicates that this element should not be considered a standoff as recited in the instant claim. Additionally, a review of the cited reference's figures shows that element 14, and correspondingly elements 32, 42 and 52, only extend a fraction of the distance through the first component 6 and therefore cannot anticipate a standoff. *See* Goiny, Figs. 1-5. As such, the referenced element would be unable to prevent axial movement of the bolt 4 in any manner whatsoever. As described in the present application, the term "standoff" refers to an element that limits penetration of a fastener when placed in service. *See* Application, page 1, lines 13-22; *see also* Application, page 5, lines 10-16. The Goiny element would, quite the contrary, tend to drive into the material during fastening. Accordingly, the cited reference does not disclose features recited in the instant claim. Thus independent claim 1 and its respective dependent claims 2 and 4-6 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Similar to claim 1, independent claims 7 and 13 both recite, *inter alia*, "a standoff portion extending from the washer portion" As argued above, the cited reference does not disclose any semblance of a standoff portion. Rather, the cited reference merely

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discloses an arcuate pressure ring 14 that is received by a prefabricated receptacle. Accordingly, the cited reference fails to disclose features of the instant claim. Thus, independent claim 7 and its respective dependent claims 8, 9, 11 and 12 as well as independent claim 13 and its respective dependent claim 14 are patentable over Goiny. Reconsideration and allowance are respectfully requested.

Again, similar to claim 1, independent claims 26 and 27 both recite, *inter alia*, “a stemmed washer having a washer portion,” as well as, “a standoff portion integral with the washer portion” Again, the cited reference does not disclose any semblance of a standoff portion. Rather, the cited reference merely discloses a spherical pressure ring 14 that mates with a receiving section 16 on a component 6. Thus, independent claims 26 and 27 are patentable over the Goiny reference. Reconsideration and allowance are respectfully requested.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim 27 under 35 U.S.C. §103(a) as being unpatentable over Goiny in view of the McKinlay reference (US 5,688,091). Applicants respectfully traverse the rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the

claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

In the instant case, the Goiny reference does not disclose all of the features of claim 27, including the standoff portion, as discussed above. Moreover, neither a review of the McKinlay reference nor the Examiner's comments regarding the McKinlay reference provides any reason to believe the McKinlay reference can satisfy the deficiencies of the Goiny reference as argued above. For example, the Examiner states, "McKinlay teaches an externally threaded fastener including a head 18 to stop the bolt from advancing too far through the joint." As such, the head 18 of McKinlay reference prevents movement of the bolt by abutting against a component. *See* McKinlay, Fig. 4, element 18. The McKinlay structure, in fact, adopts an opposite solution and, from the point of view of head 18, is no more than a conventional bolt. No standoff whatsoever can be identified. Accordingly, the head of 18 employs no semblance of a standoff as recited in claim 27. Thus, features of the recited claims are not found in the Goiny-McKinlay reference combination. Independent claim 27 is therefore clearly patentable over the reference combination. Reconsideration and allowance are respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: 12/17/2002

Respectfully submitted,

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